REMARKS

Upon entry of this Amendment, claims 1-39 will remain pending and under current examination. Applicant respectfully requests reconsideration of this application in light of the following remarks.

I. Regarding the Non-Final Office Action

In the Office Action[1], the Examiner rejected claims 12-17 and 29-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0126026 to Gronberg et al. ("*Gronberg*"); rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over *Gronberg* in view of U.S. Patent Application Publication No. 2003/0135474 to Circenis et al. ("*Circenis*"); and rejected claims 18-28 under 35 U.S.C. § 103(a) as being unpatentable over *Gronberg* in view of "Official Notice."

Applicant respectfully traverses the Examiner's rejections for the following reasons.

II. Regarding the rejection of claims 12-17 and 29-39 under 35 U.S.C. § 102(e) as being anticipated by *Gronberg*

Applicant respectfully traverses the rejection of claims 12-17 and 29-39 under 35 U.S.C. § 102(e) as anticipated by *Gronberg*. In order to properly establish that *Gronberg* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Gronberg does not disclose each and every element of Applicant's claimed invention. Claim 12 calls for a combination including, for example, "a get module to retrieve from a metrics database a set of tags corresponding to the tag identifiers and to determine a subset of unique tags from the set of tags based on a condition" (emphasis added). *Gronberg* fails to teach at least this element of claim 12. While *Gronberg* teaches in paragraph 27 "an aggregate database 32 queries retrieving commerce item information tags 52 thereby capturing commerce metrics of a commerce item," this does not constitute a teaching or suggestion of "a get module to determine a subset of unique tags from the set of tags based on a condition," as recited by claim 12.

Accordingly, *Gronberg* cannot anticipate claim 12. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 12 as being anticipated by *Gronberg*.

Claims 13-16 depend from claim 12 and therefore include all of the elements recited therein. Therefore, claims 13-16 are allowable at least for the reasons discussed above regarding claim 12. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 13-16 as being anticipated by *Gronberg*.

With respect to claim 17, *Gronberg* does not disclose each and every element of Applicant's claimed invention. Claim 17 calls for a combination including "a group tag," "combining like additive attributes from the set of additive attributes to produce a set of group attributes; and assigning the group tag to the set of group attributes." The Examiner cites claim 11 of *Gronberg* as allegedly teaching "a group tag" (Office Action at p. 4). While claim 11 of *Gronberg* recites a "commerce item information tag," this does not constitute a teaching or suggestion of "a group tag," as recited by claim 17. Moreover, *Gronberg* fails to teach or suggest "combining like additive attributes from the set of additive attributes to produce a set of

group attributes; and assigning the group tag to the set of group attributes," as recited by claim 17.

Accordingly, *Gronberg* cannot anticipate claim 17. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 17 as being anticipated by *Gronberg*.

Independent claim 29, although of different scope, recites similar elements to claim 12. Therefore, claim 29 is allowable at least for the reasons discussed above regarding claim 12. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 29 as being anticipated by *Gronberg*.

Claims 30-38 depend from claim 29 and therefore include all of the elements recited therein. Therefore, claims 30-38 are allowable at least for the reasons discussed above regarding claim 29. Applicant therefore respectfully requests the Examiner to withdraw the rejection of claims 30-38 as being anticipated by *Gronberg*.

Independent claim 39, although of different scope, recites similar elements to claim 17. Therefore, claim 39 is allowable at least for the reasons discussed above regarding claim 17. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 39 as being anticipated by *Gronberg*.

III. Regarding the rejection of claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over *Gronberg* in view of *Circenis*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-11 because a *prima facie* case of obviousness has not been established with respect to claims 1-11.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Gronberg* nor *Circenis*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claim 1 recites a combination including, for example, "a procedure to retrieve from the metrics database a set of tags and to determine a subset of unique tags from the set of tags based on a condition" (emphasis added). As discussed above, *Gronberg* fails to teach or suggest at least this element. Moreover, *Circenis* fails to make up for the deficiencies of *Gronberg*. *Circenis* is relied up for allegedly teaching "a method of accessing metrics data comprising metrics data that describes a software product" (Office Action at p. 8). Even assuming the Examiner's assertion is true, *Gronberg* and *Circenis*, taken alone or in combination, fail to teach or suggest at least "a procedure to retrieve from a metrics database a set of tags corresponding to the tag identifiers and to determine a subset of unique tags from the set of tags based on a condition" (emphasis added) as recited by claim 1.

Therefore, no *prima facie* case of obviousness has been established for claim 1. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 1 as being unpatentable over *Gronberg* in view of *Circenis*.

Claims 2-10 depend from claim 1 and therefore include all of the elements recited therein. Therefore, claims 2-10 are allowable at least for the reasons discussed above regarding

claim 1. Applicant therefore respectfully requests the Examiner to withdraw the rejection of claims 2-10 as being unpatentable over *Gronberg* in view of *Circenis*.

Independent claim 11, although of different scope, recites elements similar to those of claim 17. As discussed above, *Gronberg* fails to teach or suggest each and every element of Applicant's claims. Moreover, *Circenis* fails to make up for the deficiencies of *Gronberg*. *Circenis* is relied up for allegedly teaching "a method of grouping metrics data comprising metrics data that describes a software product" (Office Action at p. 11). Even assuming the Examiner's assertion is true, *Gronberg* and *Circenis*, taken alone or in combination, fail to teach or suggest at least "a procedure to combine like additive attributes from the set of additive attributes to produce a set of group attributes; and to assign a group tag to the set of group attributes" (emphasis added) as recited by claim 11.

Therefore, no *prima facie* case of obviousness has been established for claim 11. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 11 as being unpatentable over *Gronberg* in view of *Circenis*.

IV. Regarding the rejection of claims 18-28 under 35 U.S.C. § 103(a) as being unpatentable over *Gronberg* in view of "Official Notice"

Independent claims 18 and 28, although of different scope, recite elements similar to those of claims 12 and 17. As discussed above, *Gronberg* fails to teach or suggest each and every element of Applicant's claims. The Examiner purported to take Official Notice "that a central processing unit is notoriously well known" (Office Action at p. 12). Even if this is true and if the Examiner is deemed to have properly established "Official Notice," such "Official Notice" fails to cure the deficiencies of *Gronberg* discussed above. That is, neither *Gronberg* nor the Examiner's Official Notice, taken alone or in combination, teach or suggest at least

"determining a subset of unique tags from the set of tags based on a condition," or "combining like additive attributes from the set of additive attributes to produce a set of group attributes; and assigning a group tag to the set of group attributes" as recited by claims 18 and 28 respectively. Thus, a *prima facie* case of obviousness has not been established for claims 18 and 28. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 18 and 28 as being unpatentable over *Gronberg* in view of "Official Notice."

Claims 19-27 depend from claim 18 and therefore include all of the elements recited therein. Therefore, claims 19-27 are allowable at least for the reasons discussed above regarding claim 18. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 19-27 as being unpatentable over *Gronberg* in view of "Official Notice."

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 21, 2005

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